

REMARKS

In the Final Office Action mailed November 24, 2010, the Examiner:

(1) provisionally rejected claims 30-55 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 30-55 of copending Application No. 10/573,031;

(2) rejected claims 30, 31, and 36-55 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,254,558 to Hinkle et al. ("Hinkle")¹ in view of U.S. Patent No. 6,989,820 to Baker et al. ("Baker") and U.S. Patent Application Publication No. 2003/0130937 to Reynolds ("Reynolds"); and

(3) rejected claims 32-35 under 35 U.S.C. § 103(a) as being unpatentable over Hinkle, Baker, Reynolds, and further in view of U.S. Patent No. 6,718,535 to Underwood ("Underwood").

By this Amendment, Applicant amends claims 30, 36, 40, 47, 48, 54, and 55.

Support for the amendments may be found in Applicant's Specification at, for example, page 24, lines 12-31. Claims 30-55 remain pending and under current examination.

I. Provisional Non-statutory Double Patenting

Applicant respectfully traverses the provisional double-patenting rejections and requests that the rejections be held in abeyance. Application No. 10/573,024 ("the '024 application") and Application No. 10/573,031 ("the '031 application") are currently pending and, thus, no double patenting circumstances can arise until a patent is granted. Therefore, Applicant continues to request that the provisional rejections be held in abeyance and any resolution in the form of a Terminal Disclaimer or otherwise be deferred.

¹ In the Final Office Action, the Examiner continued to list U.S. Patent No. 7,254,288 which is a patent titled "Corner Cube Depolarizer" to Kalibjian. In this Amendment, Applicant again assumes that the Examiner meant to cite U.S. Patent No. 7,254,558, which is listed in the PTO-892 form, to Hinkle et al.

II. 35 U.S.C. § 103 Rejection of Claims 30-31 and 36-55

Applicant respectfully traverses the rejection of claims 30-31 and 36-55 under 35 U.S.C. §103(a) as obvious over Hinkle in view of Baker and Reynolds. A *prima facie* case of obviousness has not been established with respect to these claims.

“The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious...[R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation omitted). “[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). ... The factual inquires...[include determining the scope and content of the prior art]...[a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). In rejecting a claim, “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Amended independent claim 30 recites, in part, “associating, by the computer, a plurality of optional states with a selected invoice in the second set of invoices; presenting the selected invoice with the plurality of optional states; receiving a selection of a first state, among the plurality of optional states, for the selected invoice.” The cited references do not teach, suggest, or render obvious at least these elements of amended independent claim 30.

Hinkle discloses “a system...configured to generate a collection priority value from information stored on the system and queue the accounts for collection action

based on the priority value and user entered filtering criteria.” Hinkle, abstract. In particular, Hinkle discloses that “[i]f the balance exceeds 114 a preset level, system 10 then queries 116 whether the balance has been due for a time within certain preset limits.” Hinkle, col. 4, ll. 45-47. “If the answer to query 116 is affirmative, and a specified form letter has not been sent previously, system 10 then sends 118 the specified form letter.” Hinkle, col. 4, ll. 49-52. However, Hinkle does not teach or suggest “a second set of invoices,” or “associating, by the computer, a plurality of optional states with a selected invoice in the second set of invoices,” as recited by amended claim 30. Indeed, Hinkle does not perform any further query if the balance exceeds the preset value. Similarly, Hinkle must also fail to teach or suggest “presenting the selected invoice with the plurality of optional states” and “receiving a selection of a first state, among the plurality of optional states, for the selected invoice,” as recited by amended claim 30.

Baker and Reynolds, alone or in combination, do not cure the deficiencies of Hinkle. Baker discloses “[a]n automated administration system for providing state-based control of soft-labeled keys (SLKs) in a wireless terminal or other type of communication system terminal.” Baker, abstract. Baker has nothing to do with “processing invoices.” Instead, according to Baker, a “state represents those events that are legitimate for the user.” Baker, col. 5, ll. 50-52. Therefore, Baker’s state does not constitute the “plurality of optional states” or the “first state” recited in claim 30. Accordingly, Baker also fails to teach or suggest “associating, by the computer, a plurality of optional states with a selected invoice in the second set of invoices,” “presenting the selected invoice with the plurality of optional states,” and “receiving a

selection of a first state, among the plurality of optional states, for the selected invoice,” as recited by amended claim 30.

Reynolds, cited merely for its teaching that “if the account has not been paid in full the link automatically provides an electronic request to a collection agency or another entity to collect on the unpaid account,” see Final Office Action, pp. 4-5 and Reynolds, para. [0052], does not teach or suggest either the “associating,” “presenting,” and “receiving” elements of claim 30.

In view of the above, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and amended independent claim 30. Consequently, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of the prior art. Accordingly, the Final Office Action has not met the burden of establishing a *prima facie* case of obviousness of claim 30, and thus, the rejection of this claim under 35 U.S.C. § 103(a) must be withdrawn.

Independent claims 54 and 55, while each of a different scope, include elements similar to those discussed above with respect to claim 30 and are allowable for reasons at least similar to those presented above with respect to claim 30. Accordingly, a *prima facie* case of obviousness has not been established for independent claims 54 and 55 for at least reasons similar to those discussed above. Therefore, the Examiner should also withdraw the rejection of claims 54 and 55 under 35 U.S.C. § 103(a) based on Hinkle, Baker, and Reynolds.

Claims 31 and 36-53 depend from independent claim 30. Therefore, a *prima facie* case of obviousness has not been established for claims 31 and 36-53 at least

due to their dependence and the Examiner should withdraw the rejection of these claims under 35 U.S.C. § 103(a).

III. 35 U.S.C. § 103 Rejection of Claims 32-35

Applicant traverses the rejection of claims 32-35 under 35 U.S.C. § 103(a) as being unpatentable over Hinkle, Baker, Reynolds, and Underwood. Underwood, cited by the Final Office Action merely for the alleged teaching of “invoices of special importance,” does not cure the deficiencies of Hinkle, Baker, and Reynolds. That is, Hinkle, Baker, Reynolds, and Underwood, taken alone or in combination, do not teach or suggest the “associating,” “presenting,” and “receiving” elements of amended independent claim 30.

For at least the above reasons, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and amended independent claim 30. Accordingly, no *prima facie* case of obviousness has been established with respect to claims 32-35 at least because of their dependency from claim 30. Therefore, Applicant respectfully requests that the Examiner withdraw the rejections of claim 32-35 under 35 U.S.C. § 103(a).

IV. CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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